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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/958,088	10/27/1997	JOHN S. HENDRICKS	5062	2949

7590 02/15/2002

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EXAMINER

GRANT, CHRISTOPHER C

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 02/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 08/958,088 Applicant(s) HENDRICKS et al.

Examiner Christopher Grant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 10/27/1997 and 5/19/1998

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 28-73 is/are pending in the application.

4a) Of the above, claim(s) 28-30, 32-56, and 60-64 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 31, 57-59, and 65-73 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892)

18) Interview Summary (PTO-413) Paper No(s). _____

Chris Grant
CHRIS GRANT
PRIMARY EXAMINER

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3, 6, 7, 10

20) Other:

19 Sheets

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DETAILED ACTION

Election/Restriction

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

The species illustrated in figures 4, 5a, 5b, 6a, 6b, 6c, 7, 8, (9a,9b), 11 and 12 respectively.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims appear generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Shawn Wooden and John Harrop on 2/6/2002 and 2/7/2002 a provisional election was made with traverse to prosecute the invention of figure 12 species. Affirmation of this election must be made by applicant in replying to this Office action.

Applicant's comments:

Applicant's representatives contend that elected figure 12 includes figures 7, 9a, 9b and 8. They contend that figure 7 is a subset of what is shown in figure 12 and that there is obviously an overlap between the two figures. They contend that figures 9a, 9b and 8 basically show different embodiments of the combiner (element 104) shown in figure 12. The representatives indicated that claims 31, 47-49, 55-59 and 65-73 are readable on elected figure 12.

Examiner's comments:

The examiner contends that claims 47-49 are readable on the species illustrated in figures 5a-6c. There are no discussions (in the specification as filed) of the "demultiplexer...performing selection of the desired programs or channels according to instructions sent from the CPU" (as recited in claim 47) in relation to elected Figures 12, 9a, 9b, 8 and 7.

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Election claims status:

Claims 31, 57-59 and 65-73 have been considered on the merits.

Claims 28-30, 32-56 and 60-64 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 57-59, 65-66 and 70-73 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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The current invention is a system for cherry-picking desired digital programs or channels from one or more multiplexed signals comprising, a CPU that manages, monitors and ensures that programs are selected and sends instructions, a digital logic for selecting programs in accordance with instructions from the CPU and serializer for combining selected programs.

The specification fails to enable one skilled in the art to make or use the “CPU managing and monitoring the digital logic component and the serializer” as recited in claim 57 (last line).

The specification, at page 31, lines 7-10, describes that “*In addition to providing instructions to the combiner 104 for selection of videos, the control CPU (90) effectuates the combining process and monitors the process to ensure the integrity of the combined signal*” and, at page 30, lines 29-30, describes that “*The control CPU 90 also sends control signals to the digital logic 146*”.

The specification does not recite that the CPU manages and monitors the serializer as recited in the claim.

Figures 7, 8, 9a, 9b and 12 do not show any connection from CPU (90) to the serializer (148) as indicated in the claim.

The specification fails to enable one skilled in the art to make or use “*a method of filtering unwanted digital programs or channels from one or more multiplexed signals comprising the steps of receiving information..., generating instructions...., removing*

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unwanted digital programs or channels.... and combining the remaining plurality of digital programs or channels into a combined signal for transmission” as recited in claim 70.

The specification (at pages 40-42) and figure 10C, describe deleting “segments” or “packets” caused by FIFO overflow. Further note that “Segments” or “packets” are not programs or channels.

6. Claims 70-73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 70 is vague because the phrase “*combining the remaining plurality of digital programs or channels into a combined signal for transmission”* (recited in the last two lines of the claim) suggests that the remaining digital signals are combined with another signal. However, note that there are no other signals for the remaining digital signals to be combined with.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 31 is rejected under 35 U.S.C. 102(b) as being anticipated by Ballantyne .

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et al. (Ballantyne) (patent 5133079 provided by applicant in the IDS filed 2/4/1998).

Considering claim 31, Ballantyne discloses a cable headend for a television program delivery in figures 1A and 1B. Note the following:

a) the claimed signal processor comprising means for receiving, means for selecting and combiner means is met by:

- i) means (12) of fig. 1A or 1B, for receiving plural video signals;
 - ii) means (16) via control (18) (fig. 2B) for selecting requested video programs, see col. 4, lines 3-19; and
 - iii) combiner means (20);
- b) the claimed network controller comprising means for obtaining, computer processor, means for transferring and means for distributing is met by:
- i) means (14) for obtaining communications from settop terminals;
 - ii) computer processor (14) for generating instructions for the signal processor, see col. 4, lines 3-19;
 - iii) means (18) for transferring the instructions to the signal processor, see col. 4, lines 20-26; and
 - iv) means (24, 26) for distributing the combined video signals to set top terminals, see col. 4, lines 39-55.

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Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 67-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nemirofsky (patent 5412416) and Wasilewski et al. (Wasilewski, patent 5400401) (provided by applicant in the IDS filed 2/4/1998).

Considering claim 67, Nemirofsky discloses a method for cherry-picking programs (20, 22) comprising:

- a) receiving information (system control computer 26) and one or more signals (20, 22), wherein the information includes data on identities...(col. 5, line 40 - col. 6, line 51);
- b) generating instructions (computer 26) using the received information (col. 5, lines 53-64 and col. 6, lines 22-28);
- c) selecting desired programs using the generated instructions (computer 26 and insertion unit (38) select desired programs, col. 5, line 40 - col. 6, line 51);
- d) combining the selected programs (44).

Although, Nemirofsky discloses analog programs, he fails to disclose digital programs from one or more multiplexed signals as recited in the claim.

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Wasilewski discloses a system and corresponding method (figure 17) for selecting digital programs for transmission comprising receiving (402) digital programs from multiplexed signals, demultiplexing (404) the digital signals, selecting and/or inserting (406) digital local programs with the digitally received programs and combining (412) the digitally received programs and digital local programs for transmission. Wasilewski's system is a digital cable headend that provides greater flexibility, improved picture quality and the greater transmission bandwidth (see columns 1-2, 22 and 26).

Wasilewski fails to specifically disclose receiving information including data on identities of the desired programs and generating instructions using the received information as recited in the claim.

It would have been obvious to one of ordinary skill in the art to modify Nemirofsky's system to include digital programs from one or more multiplexed signals, as taught by Wasilewski, for the advantage of facilitating a cable headend system that provides greater flexibility, improved picture quality and the greater transmission bandwidth.

Alternatively, it would have been obvious to one of ordinary skill in the art to modify Wasilewski's system to include receiving information including data on identities of the desired programs and generating instructions, as taught by Nemirofsky, for the advantage of providing an efficient technique to direct selection or insertion of programs for transmission to viewers.

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Claim 68 is met by the combined systems of Nemirofsky and Wasilewski, wherein Wasilewski discloses demultiplexing (404) the multiplexed signals.

Claim 69 is met by the combined systems of Nemirofsky and Wasilewski, wherein (i) Nemirofsky discloses inserting local programs (22) and combining local programs (22) with selected programs (20) or (ii) Wasilewski discloses inserting local programs (408) and combining local programs (408) with selected digital programs received via receiver (402).

Conclusion

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry and for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris Grant whose telephone number is (703) 305-4755. The examiner can normally be reached on Monday-Friday from 8:00am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306 0377.



Christopher Grant
Primary Examiner
February 8, 2002